

### **REMARKS**

Applicants hereby reaffirm the election requirement of invention I of claims 1-20 in accordance with the previous response and by the present amendment, have canceled claims 21-28 which stand withdrawn from consideration.

The allowance of claims 2-7, 17 and 18 and the indication that claims 8, 9, 11, 12 and 14-16 are objected to as being dependent on a rejected base claim, is acknowledged. Applicants note that the objected to claims have been retained in dependent form at this time, since applicants submit that by the amendment presented herein, the parent claims with respect to the objected to claims should now be in condition for allowance.

By the present amendment, claim 1 has been amended to further define features of the present invention, as will be discussed below, and claims 19 and 20 which stand rejected under 35 U.S.C. §112, second paragraph, have been amended in a manner which is considered to be in compliance with 35 U.S.C. §112, second paragraph, such that claims 19 and 20, which depend respectively from allowed claims 18 and 17, should be in condition for allowance with the parent claims.

Turning to the rejection of claims 19 and 20 under 35 U.S.C. §112, second paragraph, applicants note that by the present amendment, claim 19 has been amended to more properly recite the dependent relationship with claim 18, in that claim 19 now recites "A near-field optical probe according to claim 18, wherein said near-field optical probe forms part of a near-field microscope." In a somewhat similar manner, claim 20 has been amended to now recite "A near-field optical probe according to claim 17, wherein said near-field optical probe forms part of an optical recording/reading device." and thus, claims 19 and 20 are considered to be in compliance with 35 U.S.C. §112, second paragraph, and to properly depend from their respective parent claims 18 and 17. Thus, applicants submit that claims 19 and 20 should now be considered to be in compliance with 35 U.S.C. §112, second

paragraph, and should be considered allowable together with the parent claims thereof.

As to the rejection of claims 1, 10 and 13 under 35 U.S.C. 102(a) as being anticipated by Hirokane et al (US 5,982,409), this rejection is traversed insofar as it is applicable to the present claims, and reconsideration and withdrawal of the rejection are respectfully requested.

At the outset, as to the requirements to support a rejection under 35 U.S.C. 102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 U.S.C. §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

Before discussing the rejection over the cited art, applicants note that by the present amendment, independent claim 1 from which claims 10 and 13 depend directly or indirectly, has been amended to recite the feature of "wherein a localized plasmon is excited inside of said metallic scatterer". Reference is made to the description at page 29, line 28 to page 30, line 19, for example, which describes the fact that a metallic scatterer fabricated in the form of a circular cone or a polygonal pyramid as recited in claim 1, serves for producing a localized plasmon in the scatterer. As described, the localized plasmon is a state of residence of electrons

appearing in an elliptic body having a size equal to or less than the wavelength of the light or in a metallic projection (such as the vertex of a circular cone or the vertex of the elliptic or triangular film) sharply pointed to have a radius of curvature equal to or less than the wavelength of light and when the localized plasmon takes place, a field of quite strong light is generated in the vicinity of the metal. As further indicated, the localized plasmon is excited by light having a particular wavelength and its residence wavelength is determined by a type of the metal, a contour of the metal, and a direction of polarization of the exciting light. Furthermore, as described at page 45, lines 16-21, the near-field optical probe according to the present invention having the construction as claimed enables generation of quite strong near-field light as obtained by producing a localized plasmon in the metallic scatterer. As such, the feature now recited in claim 1 finds clear support in the specification of this application.

Irrespective of the Examiner's position concerning Hirokane et al, applicants submit that this patent fails to disclose in the sense of 35 U.S.C. 102 a metallic scatterer fabricated on the substrate in the manner as defined "wherein a localized plasmon is excited inside of said metallic scatterer". As is apparent from the description at page 30 of the specification of this application, the excitation of a localized plasmon inside the metallic scatterer is not a "inherent" feature such that applicants submit that the Examiner cannot contend that Hirokane et al discloses the claimed feature in the sense of 35 U.S.C. 102, since applicants submit that the Examiner cannot establish inherency as required by In re Robertson, supra. Thus, applicants submit that claim 1, as amended, patentably distinguishes over Hirokane et al in the sense of 35 U.S.C. 102 and the dependent claims 10 and 13, recite additional features, which when considered in conjunction with parent claim 1, should be considered allowable therewith. Accordingly, applicants submit that claims 1, 10 and 13 should now be in condition for allowance.

With respect to the objected to claims which depend directly or indirectly from claim 1, hereagain, applicants submit that in view of the allowability of claim 1, as pointed out above, the objected to claims should also be in condition for allowance at this time.

In view of the above amendments and remarks, applicants submit that all claims present in this application should now be in condition for allowance, and issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (500.39093X00) and please credit any excess fees to such deposit account.

Respectfully submitted,



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